

## REMARKS

Claims 1-26 and 34-39 appear in this application for the Examiner's review and consideration. New claims 34-39 have been added.

Claims 27-33 have been canceled without prejudice solely to expedite the allowance of the remaining claims. Applicant expressly reserves the right to file one or more continuation and/or divisional applications directed to the subject matter of the canceled claims and/or subject matter of the present amendments.

A "marked-up" version of the claims indicating the changes to the claims is attached hereto as Exhibit A. Matter deleted from the claims is indicated by brackets and added matter is indicated by underlining. A "clean" copy of all the claims, including those as amended, is attached hereto as Exhibit B. A "marked-up" version of the specification indicating the changes thereto is attached hereto as Exhibit C. Matter deleted from the specification is indicated by brackets and added matter is indicated by underlining. For the Examiner's convenience, a copy of the new Abstract is attached hereto as Exhibit D.

Numerous clarifications have been made to the specification, claims and Abstract to correct spelling, grammatical, typographical, translation and clerical errors and to clarify certain language used. All the amendments, and the new claims, are fully supported by the specification and claims as originally filed and no new matter is being introduced. In particular, the amendments to page 4, line 30 are supported by, e.g., page 13, lines 6-8. The amendments to page 5, lines 6-7 are supported by, e.g., page 18, lines 27-33. The amendment to page 6, line 19 of the specification is supported by, e.g., page 10, lines 2-4. The amendment to page 6, line 25 of the specification is supported by, e.g., page 6, line 27. The amendments to page 6, line 26 and page 7, line 9 of the specification are supported by, e.g., page 23, lines 24-25. The amendments to page 8, lines 6-7 of the specification are supported by, e.g., page 6, lines 19-20 and Figure 2. The amendments to page 9, lines 21-23 of the specification is supported by, e.g., page 9, line 23 through page 10, line 2; page 12, lines 21-28; and page 20, lines 7-16. The amendment to page 10, line 3 of the specification is supported by, e.g., page 6, line 19. The amendments to page 11, line 12; page 22, lines 10, 17 and 24; and page 23, lines 6, 13, 17 and 27 of the specification are supported by, e.g., page 6, lines 22-23 and page 23, lines 26-29. The amendment to page 13, line 1 of the specification is supported by, e.g., page 7, lines 27-29. The amendment to page 16, line 17 of the specification is supported by, e.g., page 16, line 1. The amendment to page 17, line 17 of the

specification is supported by, e.g., page 13, line 29 of the priority document, which uses the phrase “ou limiter au maximum,” which is believed to translate to “or limit to the maximum extent.” The amendments to page 18, line 27 through page 19, line 1 of the specification are supported by, e.g., page 8, lines 7-10; page 13, lines 6-8; page 23, line 30 through page 24, line 3; page 26, lines 27-29; and Figure 3. The amendment to page 22, line 10 of the specification is supported by, e.g., page 11, lines 12-13. The amendment to page 23, lines 3-7 of the specification is supported by, e.g., page 6, lines 21-23.

The amendments to claims 1 and 20 are supported by, e.g., page 6, lines 16-32; page 8, lines 1-23; page 9, line 19 through page 10, line 2; page 11, lines 1-19; page 23, line 30 through page 24, line 3; the Figures; and the respective claims as filed. The amendments to claim 6 are supported by, e.g., page 11, lines 10-13. The amendments to claims 10 and 23 are supported by, e.g., page 8, lines 1-23. The amendments to claims 14 and 25 are supported by, e.g., page 13, lines 6-8. The amendments to claim 17 are supported by, e.g., page 18, lines 25-33.

New claim 34 is supported by, e.g., claims 27 and 28 as filed. New claim 35 is supported by, e.g., claim 29 as filed. New claim 36 is supported by, e.g., claim 30 as filed. New claim 37 is supported by, e.g., claim 31 as filed. New claim 38 is supported by, e.g., claim 32 as filed. New claim 39 is supported by, e.g., claim 33 as filed.

Favorable consideration of the application in view of the amendments and remarks herein is respectfully requested.

#### **1. Objection to the Drawings under 37 C.F.R. § 1.83(a)**

The drawings are objected to under 37 C.F.R. § 1.83(a) in paragraph 5 of the Office Action because they do not show “sublayers 3a and 3b.” Similarly, certain claims, e.g., claim 17, are objected to in paragraph 9 of the Office Action because they do not recite “sublayers 3a and 3b.”

Enclosed herewith as Exhibit E is a proposed revised Figure 3, the “After” portion of which, in highlighting, shows how the layers of the collapsed bubble to one side of the resealing region can be denoted as 3', for the adhesion layer, and 4', for the tearable welding layer, as a convenient way to refer to them and of distinguishing them from the adhesion layer 3 and the tearable welding layer 4 present in the collapsed bubble on the opposite side of the resealing region. This proposed revision is supported, e.g., by page 18, line 22 through page

19, line 9 of the specification. Moreover, the claims have been clarified so as not to recite 3a and 3b.

The Examiner is respectfully requested to approve the proposed revisions to Figure 3. Upon approval, applicant will file a new Figure 3, if required, that includes these revisions. Accordingly, applicant submits that the objection under 37 C.F.R. § 1.83(a) has been overcome and requests that it be withdrawn.

## **2. Objections/Rejections under 35 U.S.C. § 112, ¶ 1**

Claims 1, 13-16, 20 and 25 are rejected under and portions of the specification are objected to under 35 U.S.C. § 112, ¶ 1 in paragraphs 6 and 10 of the Office Action.

As already discussed, numerous clarifications have been made to the specification, claims and Abstract to correct spelling, grammatical, typographical, translation and clerical errors and to clarify certain language used.

In particular, with regard to the use of “prime” numbers and letters, the claims have been clarified so as not to recite “prime” numbers and letters. Moreover, as discussed in the previous section, Figure 3 relating to the embodiment of a collapsed bubble has been revised to show how the “prime” notation is used to distinguish layers of the collapsed bubble to one side of the resealing region from those on the opposite side of the resealing region.

The specification, e.g., at page 9, lines 19-22, uses the “prime” notation for convenience when a multilayer film is in contact with itself (e.g., “welded to itself” at page 9, line 21), as a way to distinguish materials or layers on one side of a contact from those on the opposite side of the contact. For example, the structure of container A, when welded to itself, is denoted as “A” on one side of the weld and “A' ” on the other side of the weld. Obviously, as A is welded to itself, the number and composition of layers, for example, on each side of the weld must be the same, as disclosed in the specification at, e.g., page 9, lines 21-22 and page 9, line 33 through page 10, line 2. Similarly, in a bubble before collapse, adhesion layer 3 is denoted for convenience, after the bubble is collapsed, as “3” on one side of the resealing region and “3' ” on the other side of the resealing region. Thus, pages 4, 5, 9, 10 and 18 of the specification as filed, where the “prime” notation originally appeared, have been amended to eliminate or clarify its usage.

Regarding the terms “PE” appearing at, e.g., page 1, line 20 and in claims 14 and 25, and “PE metallocene” appearing in, e.g., claims 15, an artisan of ordinary skill would readily understand the polyethylene materials to which these terms refer.

First, the specification discloses many kinds of PE or polyethylene, e.g., HDPE, MDPE, LMDPE, LDPE, LLDPE, VLDPE and metallocene PE, on page 12, lines 9-11. That “PE” is an abbreviation or symbol for “polyethylene” is well known to one of ordinary skill in the art. For example, the text “Introduction to Polymer Chemistry” by R.B. Seymour, McGraw-Hill Book Company, New York, 1971, provides, in its Appendix I entitled “Symbols,” a listing of common terms relating to polymers and their abbreviations. This text, having been published in 1971, before the filing date of the above-captioned application, is therefore representative of the state of the polymer art that would have been known to one of ordinary skill therein on or about the filing date of the present application. A copy of the pertinent pages is attached hereto as Exhibit F for the convenience of the Examiner. Listed on the second line from the end of page 405 is the abbreviation “PE,” which is defined as an abbreviation for “polyethylene.”

Thus, one of ordinary skill in the art would readily recognize that “PE” refers generally to “polyethylene.”

Additionally, numerous patents contain detailed disclosures of PE and PE metallocene. In fact, U.S. Patent No. 5,882,749 to Jones et al., which issued on March 16, 1999, before the filing date of the present priority application, and which is cited by the present Office Action, discloses various types of polyethylenes, e.g., LDPE, LLDPE, VLDPE, MDPE and HDPE at col. 8, lines 64-67.

Moreover, many other patents filed and/or issued before the filing date of the present priority application explicitly disclose and/or claim “metallocene PE,” therefore, this term is well known to those of ordinary skill in the art. For example, U.S. Patent No. 5,843,540 issued on December 1, 1998 (“Multi-Layer Flexible Container for Flowable Materials”) discloses, at col. 12, line 11, the use, in a flexible container, of a layer of metallocene PE. A copy of this patent is enclosed as Exhibit G for the Examiner’s convenience. Additionally, U.S. Patent No. 5,830,545 issued on November 3, 1998 (“Multilayer, High Barrier Laminate”) discloses, e.g., at col. 3, lines 57-60, and claims, e.g., claims 4, 15, 22, 28, 35, 42, 49 and 56, metallocene polyethylene as the polyethylene material layer in a multilayer pouch structure. A copy of this patent is enclosed as Exhibit H for the Examiner’s convenience. Furthermore,

U.S. Patent No. 5,770,318, filed on January 13, 1995 and issued on June 23, 1998, (“Thermoplastic Seal and Wrapping Film”) presents, in columns 1-4, an extensive discussion of the history of PE and metallocene PEs (see, particularly, col. 4, lines 1-48 for metallocene PE) and the catalysts for making them, and, in columns 6-7, has an extensive discussion of the following commercial grades (c.a. 1995) of metallocene PEs: Exxon EXACT® and Dow AFFINITY® and ENGAGE®. A copy of this patent is enclosed as Exhibit I for the Examiner’s convenience. Each of the foregoing patents relating to “PE” and “PE metallocene” is therefore representative of the state of the polymer film or layer packaging art that would have been known to one of ordinary skill therein on or about the filing date of the present application.

Thus, one of ordinary skill in the art would readily recognize that “metallocene PE” refers generally to “a polymer or copolymer comprising ethylene made using a metallocene catalyst(s).”

Regarding the term “master batch” appearing in, e.g., claim 13, an artisan of ordinary skill would readily understand this term. For example, the reference “Hawley’s Condensed Chemical Dictionary” edited by R.J. Lewis, John Wiley & Sons, New York, 1997, provides, on pages 703-704, a definition of “master batch.” This well-known reference, having been published in 1997, before the filing date of the above-captioned application, is therefore representative of the state of the polymer art that would have been known to one of ordinary skill therein on or about the filing date of the present application. A copy of the pertinent pages is attached hereto as Exhibit J for the convenience of the Examiner. Hawley’s defines a master batch as “a previously prepared mixture composed of a base material and a high percentage of an ingredient ... that is critical to the product being manufactured. Aliquot parts of this mixture [i.e., the master batch] are added to production-size quantities (batches) during the mixing operation.”

Additionally, the specification, e.g. at page 16, line 31 to page 17, line 2, discloses that a master batch containing filler or processing agents may be used at a level of from 5-25% by weight to make up an adhesive of the invention. The specification also exemplifies master batches, *inter alia*:

- Schulman RTL 1098 master batch, composed of 70% talc flake and 30% PE resin (page 17, lines 6-7);

- Schulman Polybatch AMF 702 master batch, composed of 2% Viton Free Flow 10 from Du Pont and 98% PE resin (page 17, lines 8-10);
- a master batch containing 10% filler (page 25, line 3); and
- a master batch containing the following additives: slip agent, anti oxidant and processing aid (page 25, line 4).

Moreover, other patents filed and/or issued before the filing date of the present priority application explicitly disclose and claim “master batches,” therefore, this term is well known to those of ordinary skill in the art. For example, U.S. Patent No. 5,110,677 issued on May 5, 1992 (“Lettuce Packaging Film”) discloses, e.g., at col. 6, lines 12-18, and claims, e.g., claims 12 and 13, the use, in a multi-layer packaging film, of a layer formed using a 90% LDPE/10% colloidal silica master batch. A copy of this patent is enclosed as Exhibit K for the Examiner’s convenience. This patent is representative of the state of the polymer film or multi-layer packaging art that would have been known to one of ordinary skill therein on or about the filing date of the present application.

Thus, one of ordinary skill in the art would readily recognize the meaning of the term “master batch.”

Regarding the term “complexable layer” appearing in, e.g., claims 1, 16 and 20, an artisan of ordinary skill, upon reading the above-captioned application, would readily understand this term. It is well-established that “a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.” *In re Swinehart*, 439 F.2d 210 (CCPA 1971). Moreover, “an applicant may be his own lexicographer as long as the meaning assigned to the term is not repugnant to the term’s well known usage.” *In re Hill*, 161 F.2d 367 (CCPA 1947); *see also Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-1388 (Fed. Cir. 1992).

Applicant has set out the meaning of “complexable layer” throughout the above-captioned application. For example, this layer is defined, e.g., in the specification at page 6, line 19 and in Figures 1 and 2 as “(2)”, and disclosed to be optional in certain embodiments at page 10, lines 3-7. Further details about the “complexable layer,” including its preferred properties and compositions, are disclosed in detail in over a full page of the application - at page 11, line 10 through page 12, line 20. Additionally, the specification provides a detailed description of the composition of two exemplary and distinct complexable layers at page 24, lines 22-26 and page 26, line 27 through page 27, line 2. Thus, the meaning assigned to

“complexable layer” comports with well-established law because the specification is sufficiently clear and detailed on this point. For the sake of argument, even if there is any departure from the common usage of “complexable layer” in the present application, because of the extensive disclosure present the term would still meet the requirement of being understood by a person of experience in the field of the invention. *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Thus, one of ordinary skill in the art would readily recognize the meaning of the term “complexable layer.”

Accordingly, applicant submits that the rejections and/or objections under 35 U.S.C. § 112, ¶ 1 have been overcome and request that they be withdrawn.

### **3. Rejections under 35 U.S.C. § 112, ¶ 2**

Claims 1, 7-10, 13, 16, 18-20, 22 and 26 are rejected under 35 U.S.C. § 112, ¶ 2 in paragraph 11 of the Office Action as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the following terms are objected to:

- (1) “laid on,”
- (2) “facing said container,”
- (3) “rigid,”
- (4) “said container (A),”
- (5) “in which tearing at said seam takes place within said adhesive layer,”
- (6) “processing agents,”
- (7) “identical compositions,” and
- (8) “the coextrusion bubble.”

As already discussed, numerous clarifications have been made to the claims to correct spelling, grammatical, typographical, translation and clerical errors and to clarify certain language used. As a result, terms (1) through (5) and (7) are no longer recited in the claims and a proper antecedent basis is provided for term (8). Accordingly, applicant submits that these rejections should be withdrawn as moot.

Regarding “processing agents,” this term is well-known to those of ordinary skill in the polymer and packaging container art. For example, the reference “Kirk-Othmer Encyclopedia of Chemical Technology,” 2<sup>nd</sup> Edition, John Wiley & Sons, New York, 1968,

discloses, in an entry entitled "Plastics Technology" on page 800, that additives such as stabilizers, flame retardants, colorants, plasticizers, reinforcing agents and processing aids, i.e., processing agents, are often added to resins to produce compounded plastics. This well-known reference, having been published in 1968, before the filing date of the above-captioned application, is therefore representative of the state of the plastics and polymer processing art that would have been known to one of ordinary skill therein on or about the filing date of the present application. A copy of the pertinent pages is attached hereto as Exhibit L for the convenience of the Examiner. Kirk-Othmer further discloses, on page 802, that processing aids, such as mold lubricants, are also added to plastics to assist plastic processing and fabrication, e.g., in lamination, extrusion-lamination, hot calendaring, coextrusion, etc. Accordingly, one of ordinary skill in the art would readily recognize the meaning of the term "processing agents."

Additionally, the specification, e.g., at page 12, lines 17-20, includes a disclosure relating to "processing agents" that is consistent with and at least as encompassing as the Kirk-Othmer reference, namely that "[v]arious additives can be present, for example anti-oxidizing agents, anti-blocking agents, slip agents, etc., notably for facilitating extrusion and machinability (processability) of the film."

Thus, the term "processing agents," being already known to and available to the public, needs no further elaboration in the specification. "A patent applicant need not include in the specification that which is already known to and available to the public." *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 231 USPQ 649 (Fed. Cir. 1986); *see also Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 954 (1987); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

Accordingly, applicant submits that the meaning of the term "processing agents" is well known in the art and, therefore, that all of the rejections under 35 U.S.C. § 112, ¶ 2, having been overcome, should be withdrawn.



#### 4. **Rejection Under 35 U.S.C. § 102(b)**

Claims 1, 6 and 14 are rejected in paragraph 13 of the Office Action as allegedly anticipated by U.S. Patent No. 4,810,541 to Newman et al. ("Newman"). Applicant respectfully traverses.

Courts have established that for an anticipation under 35 U.S.C. § 102 "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988); *Minnesota Mining and Mfg. v. Johnson and Johnson Orthopedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992). Applicant respectfully submits that is improper to reject the present claims as anticipated by a reference that does not disclose each and every element.

Applicant respectfully points out that Newman does not disclose reclosable packaging. Newman's layers 15 and 17 referred to in the Office Action are made of copolymers of ethylene and vinyl acetate ("EVA") or acrylate copolymers (see col. 4, lines 42-53). One of ordinary skill in the art would recognize that such polymers are not pressure-sensitive adhesives ("PSAs"), *inter alia*, resealable, in contrast with the PSAs of the instant invention. In particular, Newman's plastic containers are extremely strong adhesives because they are hermetically sealed and easily peeled open by hand by the user without recourse to scissors or other tools ... but do not accidentally open when dropped from a height of 7 feet or more (col. 6, lines 11-16). Moreover, Newman's only example discloses a lid heat-sealed to a cup filled with water that "exhibited excellent abuse strength, i.e., when subjected to a Drop Test, i.e. the sealed, filled cup being dropped from an inclined surface (15° angle) of 41 inches in length striking a base plate at a 90° angle to the direction of fall, the cups did not split, rupture or leak." (See col. 7, lines 1-12). The entirety of the Newman patent neither discloses or even suggests anything about PSA, in fact, the term "pressure-sensitive adhesive" is not even used by Newman.

Also, the mechanism depicted at col. 6, lines 6-10 of Newman is clearly directed to a separation at the interface between layer 22 and layer 19. Thus, there will be no rupture of the layers in the flange of the container. In contrast, the present invention, e.g., as depicted in Fig. 2, features a separation within a layer in the tearable or otherwise rupturable layer.

Thus, Newman fails to teach or even suggest a reclosable packaging. Accordingly, applicant submits that the rejection of the claims as anticipated by Newman has been overcome and respectfully request that this rejection be reconsidered and withdrawn.

**5. Rejection Under 35 U.S.C. § 102(e)**

Claims 1, 6, 7-10, 14 and 16 are rejected in paragraph 14 of the Office Action as allegedly anticipated by U.S. Patent No. 6,345,726 to Beeuwsaert ("Beeuwsaert"). Applicant respectfully traverses.

Beeuwsaert discloses a packaging where the lid comprises a tearable weldable layer (3), and the tray comprises, in the following order from the bottom of the tray to the lid, a supporting later (5), an intermediate layer of PSA (6), and a weldable layer (7). (See Figure 3, the abstract and the claims). Pursuant to col. 4 lines 44-53, each of layers (3) and (7) preferably comprise 5 sub-layers. However, during the opening of Beeuwsaert's packaging, each of these layers behaves as if it were a unitary layer, i.e., each sub-layer of one of these layers remains bonded to the adjacent sub-layer(s) of that layer. (See col. 5, lines 22-27 and Figure 3). Therefore, Beeuwsaert does not disclose, or even suggest, a complexable layer between Beeuwsaert's support layer (5) and Beeuwsaert's PSA layer (6). In contrast, the present invention features such a complexable layer, e.g., the corona-treated PE complexable layer in each of Examples 1 and 2 of the present invention (page 24, lines 18-26 and page 26, lines 20-32, respectively).

Moreover, layers 9 and 10 referred to in the second full paragraph on page 8 of the Office Action are sub-layers of the unitary weldable layer (7). Additionally, layers 9 and 10 are not in contact with Beeuwsaert's support layer (5).

Thus, Beeuwsaert cannot disclose or even suggest the present invention since it fails to disclose a complexable layer in contact, directly or through a binder layer, with Beeuwsaert's base support layer (5). Accordingly, applicant submits that the rejection of the claims as anticipated by Beeuwsaert has been overcome and respectfully request that this rejection be reconsidered and withdrawn.

**6. Rejection of Claims 2-6, 11, 12 and 17-26 under 35 U.S.C. § 103(a)**

Claims 2-6, 11, 12 and 17-26 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 3,454,210 to Spiegel et al. ("Spiegel"), WO 97/19867 to Engelaere ("WO'867"), and U.S. Patent No. 4,791,024 to Clerici et al. ("Clerici") in paragraph 16 of the Office Action. The invention recited in the rejected claims is not rendered obvious by the proposed combination because, *inter alia*, these references do not even suggest the structures recited in the claims. Each secondary reference is discussed briefly in a separate section below, the primary reference having already been discussed in detail in the previous section, followed by a discussion of the combination proposed in the Office Action.

**A. Spiegel**

Spiegel is primarily concerned with a rather old embodiment of a reclosable packaging where the PSA is in the cover or lid rather than in the container.

Spiegel discloses two distinct multi-layer structures or laminates, referred to as a "30" and "31" in Figure 5 and, respectively, as "14" and "10" in Figures 1-4 therein. Cover layer structure 30 (and 14) is made up of a saran-coated polyester layer 15, a polyethylene layer 16, a PSA layer 17, and a polyethylene layer 18 (col. 2, lines 40-46; col. 4, lines 37-39). The polyethylene layer 18 is bonded to a polyethylene layer 12 of a base structure 10 made from a laminate of polyvinyl chloride 11 with the polyethylene layer 12 (col. 2, lines 29-32) or to a polyethylene layer 32 of a base structure 31 made from a laminate of nylon with the polyethylene layer 32 (col. 4, lines 39-43). Thus, there is no specific disclosure, or even any suggestion, of a semi-rigid container having a rigid layer of PVC, a layer of PE, a layer of PSA and a layer of PE.

In Spiegel, support 15 is corona treated, then coated with a layer of PE, the PE itself, in fact, is two subsequent sub-layers. Then this layer is corona treated and a layer of PSA is applied. Then another layer of PE, previously also corona treated, is applied. Thus, the manufacturing process involves at least 5 distinct process steps and a structure, as recited in the present claims, is not applied. In contrast, in the present invention, a structure comprising 3 layers would be applied, minimizing steps, and the layer coming into contact with the support is a complexable layer.

Arguing  
process  
&  
structure

Spiegel discloses that his adhesive is deposited as a solution. In contrast, the thermoplastic-elastomer based hot melt pressure-sensitive adhesives recited in claims 12 and 24 are extrudable, e.g., deposited from the melt. In particular, Spiegel teaches that a milled GR-S rubber adhesive composition “is applied with a coating roll and the web is then dried to insure removal of all solvent” (col. 3, lines 4-10). Thus, as a solvent is present in Spiegel’s adhesive, that adhesive is not an extrudable polymer or copolymer and Spiegel does not even suggest extruding his adhesive.

Applicant explicitly disputes the contention in the first full paragraph on page 10 of the Office Action that “[A]lthough Spiegel does not explicitly state whether the adhesive layer has a melting point lower than that of the welding layer, the property is inherently met” (emphasis added). Applicant submits that resorting to inherency in an obviousness rejection is legally improper because, *inter alia*, “[A] retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.” *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993).

#### **B. WO’867**

WO’867 discloses a packaging wherein the PSA is in the lid, in contrast with the present invention where the PSA is in the base member. The WO’867 lid comprises a support layer 2 (e.g., biaxially oriented polyester), a PSA layer 3, and a rupturable weldable layer 1. (See, e.g., page 7, lines 12-17; page 8, lines 24-25; page 9, lines 8-14; page 14, lines 22-27; and Figures 1 and 4). However, in WO’867, there is no layer between the support layer 2 and the PSA layer 3. Therefore, WO’867 neither discloses nor suggests a complexable layer, in contrast to the present invention.

#### **C. Clerici**

The subject of the Clerici patent, according to its title, is a “Dismemberable Adhesive Junction System” wherein, pursuant to col. 3, lines 32-34, the adhesive element is in the form of a fabric-carrier tape bearing an adhesive. As such, applicant submits that Clerici is not drawn from analogous art to the present invention and, therefore, should not be cited against the present claims.

A reference is from an analogous art if either it is “within the field of the inventor’s endeavor” or if it “is reasonably pertinent to the particular problem with which the inventor was involved.” *In re Paulsen*, 30 F.3d 1475, 1481 (Fed. Cir. 1994); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products*, 21 F.3d 1068, 1972 (Fed Cir 1994); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986). The scope of prior art is limited to that which is reasonably pertinent to the particular problem to which the invention is directed. “In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the ‘ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem to which the claimed invention is directed.’” *Nobell Inc. v. Sharper Image Corp.*, 16 USPQ2d 1380, 1382 (N. D. Cal. 1990), quoting *In re Antle*, 444 F.2d 1168, 1171-2; 170 USPQ 285, 287-8 (Ct. Cl. 1971). § 103 does not require the presumption of full knowledge by the inventor of prior art outside the field of his endeavor. *In re Antle*, 444 F.2d at 1171; 170 USPQ at 287.

Clerici is concerned with the subject of a repetitively joinable adhesive element made from a mixture of elastomeric materials, e.g., natural rubber and butadiene-styrene rubber, firmly anchored to one side of a carrier, e.g., a fabric such as woven cotton or nonwoven calendered polyethylene mat, or a polyvinylchloride tape (see col. 1, lines 52-59; col. 2, lines 25-32; col. 3, lines 32-34; col. 4, lines 7-9, 46-48 and 60-63; and col. 5, lines 1-5). In contrast, the field of endeavor of the present invention concerns a multilayer structure which can be readily opened and resealed or reclosed, e.g., reclosable packaging and/or containers, comprising a tearable welding layer, e.g., see page 1, lines 7-9 and claims 1 and 20. Thus, Clerici is not within the applicant’s field of endeavor, as one of ordinary skill in the art of reclosable packaging would not consult the field of repetitively joinable fabrics.

One particular problem to which the present invention is directed is obtaining a package that can be used under pressure or vacuum, that is either rigid or flexible, and that can be used in diverse types of existing packaging equipment, e.g., horizontal form, fit and fill (“FFF”) equipment and vertical FFF equipment (page 2, lines 24-28). Another particular problem to which the present invention is directed is avoiding the use of costly ionomer resins, which make the packaging in which they are used relatively expensive (page 2, lines 30-33). Clerici is not reasonably pertinent to either of these problems.

Therefore, because Clerici is neither “within the field of the inventor’s endeavor” nor “reasonably pertinent to the particular problem with which the inventor was involved,” applicant submits that Clerici should not even be cited to reject the present claims.

Nevertheless, Clerici discloses that there is no layer between the adhesive and its supporting layer. For example, Figure 2 of Clerici discloses his elastomeric material 10b directly in contact with carrier 10a and his elastomeric material 11b directly in contact with carrier 11a (see col. 3, lines 24-30).

**D. The Combination of Beeuwsaert in View of Spiegel, WO’867 and Clerici**

The Office Action alleges in paragraph 13 that claims 1-4, 6, 7, 12 and 13 are unpatentable over the combined teachings of Beeuwsaert in view of Spiegel, WO’867 and Clerici. Applicant respectfully traverses.

The Examiner has the burden under Section 103 to establish the *prima facie* obviousness of the novel methods claimed in the present application. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three elements must be shown: (1) a particular prior art reference (or references when combined) teaches or suggests all of the limitations of the claim challenged; (2) a suggestion or motivation exists in the prior art to make any required modification or combination in/of the references cited against the claim; and (3) there is a reasonable expectation of success. MPEP § 2142. Both the suggestion and expectation of success must be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). “Obvious to try” is not the standard under § 103. Exploration of a new technology or general approach that seems to be a promising field can at the same time be “obvious to try” but legally nonobvious under § 103. *In re O’Farrell*, 853 F.2d at 903, 7 USPQ2d at 1681. A mere obvious to try is not enough to establish *prima facie* case of obviousness; there must be a reasonable expectation of success. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991). If it is not shown that the prior art gives a reason or motivation to make the claimed compositions, then there is no *prima facie* case and the applicant should prevail. *In re Grabiak*, 769 F.2d 729 (Fed. Cir. 1985). Care must be exercised not to use the applicant’s disclosure to fill in the gaps in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Grabiak*, 769 F.2d 729 (1985).

First, Clerici is neither within the applicant's field of endeavor nor is this reference reasonably pertinent to either of these particular problems addressed by the present invention, as discussed above. Therefore, Clerici, whether cited alone or in combination, is not within the limited scope of prior art that can be cited against the present claims.

However, even if for the sake of argument the references are combined as suggested in the present Office Action, applicant submits that none of Beeuwsaert, Spiegel, WO'867 and Clerici disclose or even suggest the present invention, *inter alia*, because:

- A complexable layer, missing from at least Beeuwsaert, WO'867 and Clerici, would need to be added between the PSA layer and the support layer,
- Spiegel's central adhesive layer would need to be discarded,
- In favor of a PSA of one of the other references, however,
- Clerici's adhesive carrying fabric support used with a PSA would need to be discarded because it is not extrudable.

Thus, the proposed combination of references fails to teach or suggest all of the limitations of the claims. Therefore, there can be no *prima facie* obviousness.

Furthermore, the Office Action points to no suggestion or motivation existing in either reference to make the combination and the required modification discussed above. Applicant submits that, *inter alia*, neither of the cited references provide, within the disclosure of these references, one of ordinary skill in the art with the suggestion or motivation to combine their teachings and make the numerous modifications required to even approach the presently claimed invention. Therefore, there is no *prima facie* obviousness for at least this reason as well.

Even if, only for the sake of argument, the references were to be combined as suggested in the present Office Action, the presently claimed invention could be, at most, merely obvious to try, which is insufficient to establish *prima facie* case of obviousness because a reasonable expectation of success would be lacking. Applicant submits that because, *inter alia*, so many modifications of the disclosures of the references would be required, as described above, to even approach the presently claimed invention, that the expectation of success for such modifications, were they even to be undertaken, cannot be found within the references. The expectation of success must be found in the references, not

in applicant's disclosure, and the present Office Action points to no such suggestion in any reference. Therefore, there is no *prima facie* obviousness for at least this additional reason.

To support a rejection for lack of obviousness under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1575 (Fed. Cir. 1984). The prior art must teach or suggest all of the claim limitations. MPEP §2143. Where the proposed combination of art does not arrive at the claimed composition, the mere fact that the prior art could be so modified does not render obvious the claimed compositions unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, at 902 (Fed. Cir. 1984). The prior art must provide one of ordinary skill in the art with the motivation to make the modifications required to arrive at the claimed composition. *In re Lulu*, 747 F.2d 703 at 705 (Fed. Cir. 1984). Both the suggestion and expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Moreover, claims 12 and 24 recite, *inter alia*, a thermoplastic elastomer-based hot melt adhesive. Spiegel discloses that his adhesive is a milled GR-S rubber adhesive composition and "is applied with a coating roll and the web is then dried to insure removal of all solvent" (col. 3, lines 4-10). Those of ordinary skill in the art recognize that GR-S rubber is synonymous with SBR rubber, i.e., styrene-butadiene rubber, and that, therefore, each refers to the same copolymer of styrene and butadiene, e.g., as documented in the "Textbook of Polymer Science," 2<sup>nd</sup> Ed., F.W. Billmeyer, Jr., Wiley-Interscience, New York, 1971, pp. 394-395, a copy of which is attached hereto as Exhibit M for the convenience of the Examiner. As discussed therein under the heading "Processing of SBR" on page 395, the processing differences between GR-S/SBR and other rubbers, such as natural rubber, are minor. Therefore, GR-S, like natural rubber, is not extrudable, but must be deposited as a layer in some other form, e.g., by drying to remove the solvent from Spiegel's GR-S coating solution.

In contrast, the thermoplastic elastomer-based hot melt adhesive recited in claims 12 and 24 is based on a thermoplastic elastomer that is extrudable. Thus, for at least this reason, one of ordinary skill in the art would recognize that Spiegel's GR-S/SBR rubber and an extrudable thermoplastic elastomer are not interchangeable and cannot be freely substituted.



Applicant submits that there is no *prima facie* obviousness because none of Beeuwsaert, Spiegel, WO'867, Clerici, or the proposed combination, teaches or even suggests all of the limitations of claims 12 and 24, the Office Action fails to specify a suggestion or motivation existing in the reference(s) to make any required modification of the reference(s) cited against this claim, and/or the Office Action fails to specify a reasonable expectation of success existing in the reference(s) even if the required modifications were made.

Furthermore, regarding claim 19, it recites collapsing the co-extrusion bubble in an oxidizing medium. Spiegel discloses an electrostatic discharge treatment to, e.g., the exposed surfaces of his polyethylene layers 16 and 18, to oxidize those surfaces and increase their wettability to water before his adhesive is contacted therewith (col. 3, lines 1-4 and 11-16; col. 4, lines 48-52). Thus, Spiegel does not disclose or even suggest any oxidizing treatment of his adhesive, just oxidizing treatment of a layer to which the adhesive is applied or contacts.

In contrast, the recited oxidizing medium clearly refers to the oxidizing nature of the medium inside of the co-extrusion bubble. For example, the specification, at page 19, lines 10-13, discloses that when extruding the tube or bubble, air is generally employed for blowing or expanding the bubble, not unlike how air is used to expand a balloon, and the air produces a slight surface oxidation of the adhesive layer inside the bubble, e.g., the innermost surface of adhesive layer 3 in Figure 3 "Before". The specification further discloses that ozone can be employed as the oxidizing agent (page 19, lines 19-21). Thus, the present claims recite an oxidizing treatment of the adhesive.

Applicant submits that there is no *prima facie* obviousness because none of Beeuwsaert, Spiegel, WO'867, Clerici, or the proposed combination, teaches or even suggests all of the limitations of claim 19, the Office Action fails to specify a suggestion or motivation existing in the reference(s) to make any required modification of the reference(s) cited against this claim, and/or the Office Action fails to specify a reasonable expectation of success existing in the reference(s) even if the required modifications were made.

Additionally, regarding claim 11, it recites that the tearable-welding layer's melting point is greater than the pressure-sensitive adhesive layer's melting point. Because Spiegel's disclosure cannot legally be relied upon for the reasons discussed above to supply a missing property not disclosed or suggested, only alleged to be inherently present, applicant submits

that there is no *prima facie* obviousness because none of Beeuwsaert, Spiegel, WO'867, Clerici, or the proposed combination, teaches or even suggests all of the limitations of claim 11, the Office Action fails to specify a suggestion or motivation existing in the reference(s) to make any required modification of the reference(s) cited against this claim, and/or the Office Action fails to specify a reasonable expectation of success existing in the reference(s) even if the required modifications were made.

Therefore, applicant submits that the rejection of the claims over the cited combination of references has been overcome and respectfully request that the rejection be withdrawn.

**7. Rejection of Claim 13 under 35 U.S.C. § 103(a)**

Claim 13 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 5,167,339 to Takata et al. ("Takata") in paragraph 17 of the Office Action. The invention recited in the rejected claim is not rendered obvious by the proposed combination because, *inter alia*, these references do not even suggest the structures recited in the claims. Applicant respectfully traverses.

As conceded in the first full paragraph on page 12 of the present Office Action, "Beeuwsaert fails to teach an adhesive comprising from 5-25% by weight of filler or processing agent within the adhesive." Therefore, the Office Action cites Takata for its disclosure of "a resealable container that has an adhesive that contains between 0 and 95% filler for the purpose of providing a container with a desirable peel strength as well as to provide an adhesive with high heat resistance." Applicant disputes the contention on page 12 of the Office Action that "it would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicant's invention was made to have modified an adhesive layer within a re-sealable container to include ... [the cited teachings of] Takata et al."

As discussed above, Beeuwsaert fails to teach or even suggest a complexable layer between the PSA and the support layers and Takata cannot overcome this deficiency. Applicant submits that there is no *prima facie* obviousness because none of Beeuwsaert, Takata, or the proposed combination, teaches or even suggests all of the limitations of claim 13, the Office Action fails to specify a suggestion or motivation existing in the reference(s) to

make any required modification of the reference(s) cited against this claim, and/or the Office Action fails to specify a reasonable expectation of success existing in the reference(s) even if the required modifications were made.

Furthermore, the Office Action points to no suggestion or motivation existing in any of the cited reference to make the combination and the required modification discussed above. Applicant submits that, *inter alia*, neither of the cited references provide, within the disclosure of these references, one of ordinary skill in the art with the suggestion or motivation to combine their teachings and make the numerous modifications required to even approach the presently claimed invention. Therefore, there is no *prima facie* obviousness for at least this reason as well.

Even if, only for the sake of argument, the references were to be combined as suggested in the present Office Action, the presently claimed invention could be, at most, merely obvious to try, which is insufficient to establish *prima facie* case of obviousness because a reasonable expectation of success would be lacking. The expectation of success must be found in the references, not in applicant's disclosure, and the present Office Action points to no such suggestion in either of the cited references. Therefore, there is no *prima facie* obviousness for at least this additional reason.

Therefore, applicant submits that the rejection of the claim over the cited combination of references has been overcome and respectfully request that the rejection be withdrawn.

#### **8. Rejection of Claim 15 under 35 U.S.C. § 103(a)**

Claim 15 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 5,882,749 to Jones et al. ("Jones") in paragraph 18 of the Office Action. The invention recited in the rejected claims is not rendered obvious by the proposed combination because, *inter alia*, these references do not even suggest the structures recited in the claims. Applicant respectfully traverses.

As conceded in the first full paragraph on page 13 of the present Office Action, "Beeuwsaert ... fails to explicitly teach the use of metallocene polyethylene." Therefore, the Office Action cites Jones for its disclosure of "polyethylene metallocene in the outer weldable layers of a re-closable package for the purpose of producing a heat sealable layer." Applicant disputes the contention on page 13 of the Office Action that "it would have been obvious

through routine experimentation to one of ordinary skill in the art at the time applicant's invention was made to have used metallocene polyethylene in a resealable container ... as taught by Jones ... .”

As discussed above, Beeuwsaert fails to teach or even suggest a complexable layer between the PSA and the support layers and Jones cannot overcome this deficiency. Applicant submits that there is no *prima facie* obviousness because none of Beeuwsaert, Jones, or the proposed combination, teaches or even suggests all of the limitations of claim 15, the Office Action fails to specify a suggestion or motivation existing in the reference(s) to make any required modification of the reference(s) cited against this claim, and/or the Office Action fails to specify a reasonable expectation of success existing in the reference(s) even if the required modifications were made.

Furthermore, the Office Action points to no suggestion or motivation existing in any of the cited reference to make the combination and the required modification discussed above. Applicant submits that, *inter alia*, neither of the cited references provide, within the disclosure of these references, one of ordinary skill in the art with the suggestion or motivation to combine their teachings and make the numerous modifications required to even approach the presently claimed invention. Therefore, there is no *prima facie* obviousness for at least this reason as well.

Even if, only for the sake of argument, the references were to be combined as suggested in the present Office Action, the presently claimed invention could be, at most, merely obvious to try, which is insufficient to establish *prima facie* case of obviousness because a reasonable expectation of success would be lacking. The expectation of success must be found in the references, not in applicant's disclosure, and the present Office Action points to no such suggestion in either of the cited references. Therefore, there is no *prima facie* obviousness for at least this additional reason.

Therefore, applicant submits that the rejection of the claims over the cited combination of references has been overcome and respectfully request that the rejection be withdrawn.

**9. Conclusion**

In view of all of the above amendments and remarks, applicant respectfully submits that all of the objections and rejections have been overcome. Therefore, it is believed that the present application is in condition for allowance, early notice of which would be appreciated.

No fees, other than that for extending the period for response, are believed due for this submission. However, should any additional fee(s) be required, the Patent and Trademark Office is authorized to charge the requisite amount to Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Respectfully submitted,

*Alexandra Haner, Reg. No. 45,641*

*for Charles E. Miller*

Date August 26, 2002

Charles E. Miller

24,576

(Reg. No.)

**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

Enclosures